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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,719	11/30/2000	Dale W. Malik	BS00-169	1248
28970	7590	08/10/2004	EXAMINER	
SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/725,719	MALIK, DALE W.	
	Examiner	Art Unit	
	Thong H Vu	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-19 are pending.

Response to Arguments

2. Applicant's arguments filed on 6/15/04 with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 are rejected under 35 U.S.C. § 103 as being unpatentable over Dan [6,560,639 B1] in view of Pollack [6,505,236 B1].

4. As per claim 1, Dan discloses a method of storing an e-mail communication containing an attachment file received in an e-mail server [Damn, ISP server, Fig 2], comprising the steps of:

(a) searching a database [Dan, searching the database, col 11 lines 25-37; col 12 lines 49-57] of attachment files previously stored in the email server for a copy of the attachment file from the received e-mail communication [Dan, email discussion, col 15 line 64-col 16 line 11]; and (b) removing the attachment file from the e-mail communication [Dan, attached/detached, col 15 lines 10-15; user wants to replace an image, col 25 lines 1-5]; and (c) creating a link from the e-mail communication to the previously stored attachment file in the database [Dan, hotlink, hyperlink, col 13 lines 23-40; col 21 lines 33-55].

However Dan does not detail if a copy of the attachment file is located in the e-mail server. Pollack discloses an email system wherein the attachment is compared or verified to the previously stored attachment [Pollack, col 6 lines 1-67]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of comparing the newly attachment to the previously stored attachment as taught by Pollack into the Dan's apparatus in order to utilize the database searching. Doing so would provide quick, simple and efficient process to store and retrieve th email attachment from database via Internet.

5. As per claim 2, Dan-Pollack disclose if a copy of the attachment file is not located in the e-mail server, (d) separating the attachment file from the e-mail communication and separately storing the attachment file in the database [Pollack, col 6 lines 1-67]; and (e) creating a link from the e-mail communication to the corresponding attachment file stored in the database [Dan, hotlink, hyperlink, col 13 lines 23-40; col 21 lines 33-55].

6. As per claim 3, Dan-Pollack disclose detecting the size of the attachment file associated with the received e mail communication, wherein the steps of searching the database [Dan, searching the database, col 11 lines 25-37; col 12 lines 49-57], removing the attachment file from the e-mail communication; and creating a link from the e-mail communication are only performed [Dan, hotlink, hyperlink, col 13 lines 23-

40; col 21 lines 33-55] if the attachment file is greater than a predetermined size [Dan, size, col 13 line 65-col 14 line 2].

7. As per claim 4, Dan-Pollack disclose the database of attachment files is searched by performing a checksum against the attachment file of the received e-mail communication as inherent feature of database searching.

8. As per claim 5, Dan-Pollack disclose the database of attachment files is searched by comparing properties associated with the attachment files with corresponding properties associated with the attachment file of the received e-mail communication as inherent feature of comparing attachment file.

9. As per claims 6,9 Dan-Pollack disclose (c) deleting the link from e-mail communication to the attachment file in response to a delete request; and (d) deleting the corresponding attachment file when there are no links remaining to the attachment file [Dan, attached/detached col 15 lines 10-15].

10. Claim 7 contains the similar limitations set forth of claim 1. Therefore, claim 7 is rejected for the similar rationale set forth in claim 1.

11. As per claim 8, Dan-Pollack disclose (e) if an attachment file is not a duplicate of a previously stored attachment file, storing the attachment file in the mail store and

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storing a link in the mail store between the e-mail header information and the attachment file to the received e-mail communication [Pollack, compare attachment, col 6 lines 1-67].

12. As per claim 10, Dan-Pollack disclose e-mail messages in the e-mail communications are stored with the corresponding e-mail header information in the mail store [Dan, header, col 17 lines 20-35].

13. As per claim 11, Dan-Pollack disclose the header information extracted from the attachment files includes a designation of file type [Dan, type, size, col 16 lines 60-67].

14. As per claim 12, Dan-Pollack disclose the step of comparing extracted attachment file header information is performed by searching the previously stored attachment files that are designated as the same file type as the attachment file to the received e mail communication [Pollack, compare attachment, col 6 lines 1-67].

15. As per claim 13, Dan-Pollack disclose the header information extracted from the attachment files further includes at least one of: size, creation date, revision date, author, software type, version, and revision number as inherent feature of header field.

16. As per claim 14, Dan-Pollack disclose comparing extracted attachment file header information is performed only when the size of the attachment file is greater than a predetermined size [Dan, size, col 13 line 65-col 14 line 2].

17. As per claim 15, Dan-Pollack disclose an e-mail communications server comprising:

(a) an MTA server for receiving e-mail communications from an external network; (b) a mail store for storing e-mail communications received by the MTA server; (c) a POP server for downloading e-mail communications from the mail store to client computers through an internal network [Dan, ISP server, col 9 lines 10-16, col 10 lines 34-50, Fig 2]; and

(d) e-mail attachment file checking software for determining whether attachment files in received e-mail communications are duplicates of attachment files in the mail store, wherein the mail store removes duplicate attachment files from e-mail communications [Pollack, compare attachment files, col 6 lines 1-67] and creates links from received e-mail communications to the corresponding attachment files in the mail store after the email attachment file checking software determines that the attachment files in received email communications are duplicates of attachment files in the mail store [Dan, hotlink, hyperlink, col 13 lines 23-40; col 21 lines 33-55].

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18. As per claim 16, Dan-Pollack disclose the mail store further comprises a database for storing the links from received e-mail communications to the attachment files.

19. As per claim 17, Dan-Pollack disclose a first attachment storage database for storing attachment files that are each associated with a single e-mail communication, and a second attachment storage database for storing attachment files that are each associated with a plurality of e-mail communications as a design choice of database.

20. As per claim 18, Dan-Pollack disclose the e-mail attachment file checking software only checks attachment files that are greater than a predetermined size [Dan, size, col 13 line 65-col 14 line 2].

21. As per claim 19, Dan-Pollack disclose the e-mail attachment file checking software extracts properties associated with the attachment files in the received e-mail communications, and searches the mail store for attachment files having the same properties [Dan, properties, col 17 lines 47-64; col 20 lines 30-35].

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643.

The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

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Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Thong Vu

Patent Examiner

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A handwritten signature in black ink, appearing to read 'Thong Vu', with a long horizontal stroke extending to the right.